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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,677	01/04/2002	Stephen Brian Falder	16644/09003CIP	9699

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EXAMINER	
PRYOR, ALTON NATHANIEL	
ART UNIT	PAPER NUMBER
1616	11

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/039,677	Applicant(s) FALDER ET AL.	
	Examiner Alton N. Pryor	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *7/23//03* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1 and 46-103* is/are pending in the application.

4a) Of the above claim(s) *55,57,63-69 and 72-77* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1,46-54,56,58-62,70,71 and 78-103* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,7 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Duplicate Claim Warning

Applicant is advised that should claim 59 be found allowable, claim 60 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections under 35 USC 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1,46-54,56,58-62,70,71,78-103 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating or controlling a microorganism with antimicrobial composition on a surface does not reasonably provide enablement for preventing microorganisms on a surface. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make / use the invention commensurate in scope with these claims. The asserted utility is not believable on its face. It is

not known how a method wherein an antimicrobial composition is claimed can be administered to prevent microorganisms. The state of the art is what prior art knows about the invention. There is no known art wherein a certain composition is administered to successfully prevent microorganism from appearing on a surface. The level of ordinary skill in the art is high but only in the art of treating or controlling the infestation of microorganisms on surface. The predictability or lack thereof in the art refers to the ability of one skilled in the art to extrapolate the disclosed or known results to the claimed invention. The lower the predictability, the higher the direction and guidance that must be provided by the applicant. In the instant invention the predictability is very low and consequently, the need for the higher levels of direction and guidance by the applicant. However, the amount of direction and guidance provided by the applicant is limited to treatment or control. There is no evidence in the specification that established correlation between the experiment and the claimed utility. The quantity of experimentation required to use the composition and method as claimed in the instant invention, based on applicant's disclosure would be undue because, one of ordinary skill in the art would have performed significant amount of experiments.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 61,78,86,87,92-98,101,102 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 61,78,86,87 are rejected. The term "bezenethanaminium" can not be identified in the search databases. Please check spelling.

Claims 101 and 102 are rejected as being incomplete.

Claims 72-98 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are related to: How is the composition being used in the instant method claims? What object is the composition being applied to? Presently the claim recites a method of "using" the instant composition. However, the claims do not explain the term "using". Please explain what is meant by "using".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,46-54,56,58-62,70,71,79,80,83-85,88-90,92,95-97,100,103 are rejected under 35 U.S.C. 102(b) as being anticipated by Jackson (GB 2247171; 2/26/92). Jackson teaches a bacteriologically disinfectant (cleaning agent) composition comprising 0.02-0.2% quaternary compounds such as cetylpyrdinium chloride (first compound - hydrophobic with polar nature), or alkyldimethylbenzylammonium (benzalkonium) chlorides (first compound - hydrophobic with polar nature), plus 10% monohydric alcohols such as isopropyl alcohol plus polyhydric alcohols such as polyethylene glycol (second compound - hydrophilic compound or C12-C20 surfactant) plus 0.01-0.15 % phenols such as 3-methyl-4-chlorophenol (first antimicrobial agent). Jackson teaches a method of applying the disinfectant composition to surfaces for the

purpose of killing bacteria. See abstract, page 4 lines 7-24, page 5 line 11 – page 6 line 5, claims 1-7.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 82,91,99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson as applied to claims 1,46-54,56,58-62,70,71,79,80,83-90,92,95-9,100,103 above. See 35 USC 102(b) above. Jackson teaches all that is recited in claims 82,91,99 except for the composition comprising 1 to 4% polyethylene glycol; a formulation comprising 0.5-2% of the instant antimicrobial composition; and the instant method of adding and mixing ingredients to manufacture the antimicrobial composition. It would have been obvious to one having ordinary skill in the art to determine the optimum amount of polyethylene glycol to be used in the antimicrobial composition and the optimum amount of antimicrobial composition to used in a formulation. One would have been motivated to do this in order to develop the most effective composition for disinfecting a surface. In a method of preparation the simple act of adding and mixing ingredients is well known and therefore unpatentable.

Election / Other Matters

The elected benzenethanaminium N-dodecyl-N,N-dimethylchloride compound can not be searched since the term benzenethanaminium cannot be

identified by the search databases. For this reason the elected composition is not allowable.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 703 308-4691. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 703-308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1235.

Alton Pryor
Primary Examiner
AU 1616

ALTON N. PRYOR
PRIMARY EXAMINER